

REMARKS

Claims 1-9, 12-16, 21-26 and 39-43 now stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention pursuant to the Examiner's allegations setout in detail in the report of December 16, 2004. The claims have therefore been amended to overcome these rejections and full reconsideration is requested.

Claims 1, 4-7, 12, 13, 15, 21, 22, 27, 31, 34-36, 39(as dependent from 1, 12, 21, 27, 34 and 35) and 42 now stand rejected under 35 U.S.C. 102(b), as being anticipated by Giuliano et al.

Claims 2, 3, 37, 38, and 43 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al in view of Ming-ho.

Claims 8 (and 39 and dependent therefrom) and 9 now stand rejected under 35 U.S.C. 103(a) as being unpatentable of Giuliano et al in view of Lee.

Claim 14 now stand rejected under 35 U.S.C. 103(a) as being unpatentable of Giuliano et al in view of Dimmick.

Claims 16, 23-26, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano in view of Voland.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Day et al.

Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al in view of Oda et al.

Referring now to U.S. Patent 5,743,616 to Giuliano, there is taught thin panels incorporating LEDs as seen in the Figures with emphasis being on the panels being thin. The invention of the '616 reference may include one or more thin integrated panels of light transmitting

material. At column 2, line 23, it states:

“the thickness of the panels is preferably at least that of the thickness of an LED but preferably not more than three times the thickness of the LED,”.

The panels are etched in order to provide an image or design but most assuredly the thin panels do not constitute a molded ornament. The panels of ‘616 do not reside between rails as is the case in Applicant’s invention for the display signs. The modular rail system is simply not taught in the ‘616 reference. Further, the LEDs of ‘616 are embedded and potted in place by transparent potting material with electrical wires extending therefrom as described at column 3, line 66 through to column 4, line 3. At no time are the LEDs molded within openings of the ornament or display sign when the ornament is molded or when the display sign is made as in the case of Applicant’s product described within the amended claim set.

There is no discussion whatsoever within Giuliano with respect to molded Christmas ornaments or any molded ornaments which might be used or strung together in a set of lights for decorating one’s home, a Christmas tree or the like. There are no grooves or ridges provided within the thin plates. There simply isn’t enough material to do so, so one cannot create the simulated pine cone from the teachings of Giuliano.

It is submitted according to accepted jurisprudence (previously cited and incorporated by reference in its entirety into this response) that for reference to anticipate it must describe each and every element of the invention. In this regard see In Re: Donahue previously cited. Exclusion of claimed elements from a prior art reference is enough to negate anticipation by that reference. It is therefore respectively submitted that the amended claims specifically referring to a molded ornament and including the limitation that the light source is molded in place at the same time the ornament is molded cannot be anticipated by the ‘616 reference, nor rendered obvious as a result.

The Examiner may allege an obviousness rejection on the same grounds. However for any surmised obviousness rejection, following Graham and John Deere, one would conclude that there is significant difference between the ‘616 reference and the amended claims at issue since ‘616 reference does not directly teach nor infer the combination of the claimed elements described in the above-mentioned list of amended claims for a decorative

ornament now including the limitation that the light source is molded in place at the same time the molded ornament is made.

Further there is no motivation within the '616 reference to manufacture a molded ornament from the teachings of '616. There is no reason, suggestion or motivation found in the '616 reference whereby a person of ordinary skilled in the art would arrive at the invention of a molded decorative ornament as set out in the amended claim set as represented by claim 1 namely:

A molded decorative ornament comprising a solid matrix of material providing a body having a predetermined shape, said body having at least one light scattering translucent surface, groove, ridge or characteristic formed therein, said at least one translucent surface, groove, ridge or characteristic providing a design, shape, or image, all formed by forming the groove, ridge or characteristic into the solid matrix of material of the body of the decorative ornament, said body having disposed therein an opening having contained therein in use at least one light source, molded in place within the opening when the ornament is molded, said at least one light source including electrical leads extending to an electrical conductor; the solid matrix of material being transparent and coloured for a holiday season such as amber, red, green, blue, clear, purple, yellow, or orange or combinations thereof; said light source being positioned so as to light the decorative ornament in a pleasing manner, said light exiting the light source being dispersed by said light scattering translucent at least one-surface, groove, ridge or characteristic so as to create a more uniform dispersion of the light from the decorative ornament as opposed to a point source of light, which dispersed light would remain undispersed had the surface, groove, ridge or characteristic not been provided thereby creating a pleasing and more effective ornament.

To follow the Examiner's arguments and allegations would require 20/20 hindsight which is not permissible especially in view of the present claim amendments. For example, In Re: Fritch it was held impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

Applicant therefore has, as discussed above, amended the claim set to include limitations not found in the '616 reference. Clearly all of the Examiner's rejections are based on the Giuliano reference. Any combination of her alleged primary reference with any other reference therefore cannot arrive at applicant's teaching whether combined with Ming-ho, Lee, Voland, Day et al., Dimmick and Oda in view of the present amendments. It is submitted that the '616 reference does not teach the limitations found in Applicant's amended claim set namely of molding the light source in place at the same time the molded ornament is molded or the sign is made.

It is respectfully submitted that all the claims have now been carefully amended to identify over the '616 reference and any combination that the Examiner may put forward with respect to various patents cited in her report are moot namely in view of any or all of Ming-ho, Lee, Voland, Day et al., Dimmick and Oda et al. The primary reference fails to teach any of the claims in the amended claim set and there is no motivation in Giuliano to combine with the teachings of the art Ming-ho, Lee, Voland, Day et al., Dimmick and Oda et al and arrive at Applicant's invention setout in the amended claim set, namely:

A molded decorative ornament comprising a solid matrix of material providing a body having a predetermined shape, said body having at least one light scattering translucent surface, groove, ridge or characteristic formed therein, said at least one translucent surface, groove, ridge or characteristic providing a design, shape, or image, all formed by forming the groove, ridge or characteristic into the solid matrix of material of the body of the decorative ornament, said body having disposed therein an opening having contained therein in use at least one light source, molded in place within the opening when the ornament is molded, said at least one light source including electrical leads extending to an electrical conductor; the solid matrix of material being transparent and coloured for a holiday season such as amber, red, green, blue, clear, purple, yellow, or orange or combinations thereof; said light source being positioned so as to light the decorative ornament in a pleasing manner, said light exiting the light source being dispersed by said light scattering translucent at least one-surface, groove, ridge or characteristic so as to create a more uniform dispersion of the light from the decorative ornament as opposed to a point source of light, which dispersed light would remain undispersed had the surface,

groove, ridge or characteristic not been provided thereby creating a pleasing and more effective ornament.

Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification as purported by the Examiner. With reference to In Re: Regal, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absence some "teachings, suggestion, or incentive supporting the combination"): In Re: Cho. 813 F. 2d 378, 382, 1 USPQ 2d 1662, 1664 (Fed. Cir. 1987) ("discussing the Board's holding that the artisan would have been motivated to combine the references").

For example, the Examiner has alleged that the claims specified above are obvious in relation to '616 in view of Ming Ho stating that Ming Ho at column 14 teaches displays of Santa Claus, a crucifix or a heart. That particular section specified in Ming Ho clearly makes no reference to Santa Claus, crucifix or hearts at specific lines 37 to 53. What is stated is toys, gift items, decorations, pins, buttons, badges, ornaments and the like. It is respectively submitted then that Ming Ho does not teach molded Christmas ornaments as required in Claim 2 nor Santa Claus, a crucifix or a heart as required by Claim 3. Further it is submitted that when reading the '616 reference (thin plates) one skilled in the art would not apply the teachings or combine the teachings of the Ming Ho reference since the teachings thereof are not readily combinable. **Further the alleged combination would not result in a molded decorative ornament including a light source molded in the opening when the ornament is molded.**

Referring now to Voland, U. S. 4,965,701, it teaches a curtain kit wherein the curtain is suspended as a series of parallel light ropes (which light as well) as seen in Figure 3 including a string of lights extending not molded in place but carried on an optical fibre from a horizontal member as seen in Figure 8 and utilized as illumination for divider

curtains for the interior of a dwelling. The teachings of Voland include a supporting member which the strings of the light members extend from. Clearly an illumination curtain kit including bulbs is not the same thing as a molded ornament including lights molded therein. One skilled in the art of manufacturing holiday ornaments would not look to the teachings of this reference to light curtains to separate two rooms, for example, in a dwelling. Therefore this reference cannot be readily combined with '616 to arrive at the teachings of the amended claims.

It is submitted that the dependent claims include the limitations of the independent claims from which they depend and these limitations are clearly not taught in the Voland reference or any combination of the '616 and Voland references. How therefore might a conclusion of obviousness be arrived at? The '616 structure will also not readily combine with Voland and even if they did although no admission is made to this effect, the combination would still not arrive at a molded decorative ornament as defined in claim 1 as amended for example.

Respectively the Examiner is clearly picking and choosing elements from the prior art in creating a 20/20 hindsight reconstruction. This is not permitted and in fact with the additional case law previously cited in Re: Fritch it is not permissible to use the claimed invention as an instruction manual or template to piece together the teachings of prior art so that the claimed invention is alleged as obvious. This is a 20/20 hindsight construction and the efforts of the Examiner to do so are clear in that '616 is combined with (6) six other references for the Examiner's purposes. Picking and choosing references from the prior art and combining them with '616 which is not permissible does not result in Applicant's molded ornaments as specified in the amended claims!

As specified in Re: Rouffet the court requires the Examiner to show a motivation to combine the references to create the case of obviousness. The Examiner must show reasons that the skilled artisan confronted with the same problem as the Applicant with no knowledge of the claimed invention would select the elements from the cited prior art references for combination in the manner claimed.

Referring now to Lee, '983, the Examiner alleges that the light emitting diodes are located in a rail structure but as best seen in Figure 4 the light emitting diodes are not molded in place within the sign within openings when the sign is made. This significant difference is clearly not taught in Lee but is present in the amended claim set which limitation is clearly lacking in any combination of '616 and Lee. The Examiner is advised that the amendments to claim 9 with respect to LEXAN were made by searching the internet for the actual generic material which is included within LEXAN, namely engineered thermoplastic polycarbonate resin. So the combination of '616 and Lee fall short of the amended claim set and full reconsideration of the rejected claims is respectfully requested.

Referring now to claim 14, claim 14 depends from claim 12 which defines a holiday season molded decorative ornament with the at least one light source molded therein at the same time as the ornament is molded. The fact that that ornament includes secondary light scattering means the comprising metal shadings or bubbles and the fact these limitations are alleged as being taught in Dimmick, nonetheless such allegations are moot in view of Applicant's amendments. In the first place, '616 would not combine with Dimmick. Dimmick teaches an exit sign and an exit sign only. '616 teaches very thin plates. The teachings therefore of Giuliano and Dimmick are somewhat mutually exclusive and one skilled in the art would not look to these teachings absent a 20/20 hindsight reconstruction to combine these references. Even if these references were combined in the manner alleged by the Examiner one would not arrive at Applicant's amended claim set including the molded decorative ornament wherein the light source is molded in place at the same time that the ornament is molded. Full reconsideration therefore is respectfully requested.

Referring now to claim 33 and Day, claim 33 is dependent on claim 31 which includes the limitations of the molded decorative ornament with the light source molded therein at the same time as the ornament is molded which limitation is clearly absent from '616 and further which limitation as best seen Figure 2 and 3 of Day lacks the teaching of the light source being molded in place when the molded ornament is molded. In fact, at column 2 of Day, it states that "the bead assembly has at least one light source adapted for attaching to the thread bundle at one end thereof by engaging a respective distal end of the tether and connecting the light source and the common member to a selected one of the signal members." Clearly in Day the light source is enclosed within a respective one of the

beads. There is no discussion of molding the ornament or beads and further that the light source would be molded in place within the bead when the bead is manufactured as this would be inconsistent with the teachings of Figures 2 and 3 in the description related thereto within Day.

How can any combination therefore of '616 and Day result in Applicant's amended claims and specifically in relation to claim 33. It is clear that Applicant is claiming a necklace but only in combination with the independent claim construction of claim 31 which is clearly absent from any combination that the Examiner might assert in relation to '616 in combination or in view of Day.

Referring now to the Examiner's allegations in relation to claims 40 and 41 of '616 in view of Oda, clearly Oda is teaching a lighting source for a liquid crystal display including an elongated light item 2 as seen in Figure 1 and Figure 8 which clearly cannot be molded in place within the opening contained within a sign when the sign is made. In fact, Applicant submits that Oda is not relevant and will not readily combine with '616 since the light source is bigger than any panel which is taught in the '616 reference having a thickness of no more than the diameter of 3 LEDs as stated above. How then might '616 combine with Oda which essentially is a side lighting source for a liquid crystal display for the light emitting face 12 of the light conductor 1. Clearly such a combination would be mutually exclusive and respectively impossible. The fact that Oda teaches a reflective panel is not relevant since Applicant's claims 40 and 41 not only include a reflective panel but include the limitations of claim 8, 34 and 35 which further includes the limitation as described above of the at least one light source being molded within the opening within the edge of the sign when the sign is made. Clearly this is not the case in '616 and this is clearly not the case in Oda. How can any combination therefore of Oda and '616 arrive at Applicant's claims 40 and 41 which include the limitations of the independent claims which are clearly not taught in the Examiner's alleged combination. The 20/20 hindsight reconstruction of the Examiner is readily apparent and in all cases with respect to the 6 references that the Examiner attempts to combine with '616. The Examiner is not permitted to make such combinations relying on general teachings when the 2 references themselves are not readily combinable as stated in the above case law. The Examiner makes general allegations with respect to each of the secondary references without

Appl. No 09/990,326
Amdt. dated June 15, 2005
Reply to Official Action dated December 16, 2004

showing how they might combine with '616 and yet still falls short of the amended claims limitations set out above.

It is therefore requested that the Examiner reconsider her anticipation and her obviousness rejections of the claims indicated in her report and that full reconsideration be given to the amended claim set in view of those amendments and the arguments presented above.

Applicant encloses an Information Disclosure Statement which includes US Patent 6,305,109 (Lee et al). This document was cited by the Examiner in Applicant's Canadian Application 2,360,186, from which priority is claimed. Also, a certified copy of the Canadian Application 2,360,186 is enclosed.

If the Examiner has any questions, the Examiner is respectfully requested to contact Neil H. Hughes at (905) 771-6414 at her convenience.

Respectfully submitted,

Neil H. Hughes, P.Eng.
Agent for the Applicant
Registration No. 33,636

NHH:md
Enclosures